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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,707	06/05/2001	Dan Kikinis	ISURFTV137	7928

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EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2614

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,707

Applicant(s)

KIKINIS ET AL.

Examiner

Jade O. Laye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 1,5,7,9,13,17 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/5/01, 7/19/01, 8/28/01, 1/30/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 6/5/01, 7/19/01, 8/28/01, and 1/30/02 are in compliance with the provisions of 37 CFR 1.97. Accordingly, each has been considered by the examiner.

Drawings

2. The drawings are objected to because they are not descriptively labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested the title contain reference to a remote terminal and EPG.

Claim Objections

3. Claims 1, 5, 7, 9, 13, 17, and 21 are objected to because of the following informalities:
- a. The phrase "...to receive information via wireless..." is unclear in claims 1, 9, and 17. The Examiner assumes this denotes "...to receive information via a wireless connection." However, Applicant should be clear in claiming what he or she denotes as being his or her invention.
 - b. Claims 5, 13, and 21 contain a typo. The phrase "...apparatus is personal digital assistant" should read "...apparatus is a personal digital assistant."
 - c. Claim 7 appears to contain a typo. The phrase "...wherein indicator is a unit..." should state "wherein the indicator is a unit..."

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-5, 7-13, 15-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen (US Pat. No. 6,628,729) in view of Huang et al. (US Pat. No. 6,437,836).

Claim 1 recites an apparatus comprising:

- a. A unit to transmit information and to receive information via a wireless connection;
- b. a control unit to interact with an electronic programming guide (EPG); and

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- c. an indicator to indicate an availability of an interactive function in a program corresponding to the EPG.

Sorensen discloses a hand-held device which permits remote access to data, such as an Internet address, embedded in a broadcast program received by a receiver. The system is also capable of indicating the availability of interactive data corresponding to broadcast programming being received by the system. (Col. 1, Ln. 7-10, 30-40, 50-67 thru Col. 2, Ln. 1-8 & Col. 3, Ln. 22-36). But, Sorensen fails to specifically disclose the use of an EPG. However, within the same field of endeavor, Huang et al disclose a similar hand-held system, which is capable of interacting with an EPG. (Abstract). Therefore, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to combine the systems of Sorensen and Huang in order to provide a device capable of alerting a user to the presence of interactive broadcast data corresponding to an EPG, thereby providing a remote with extended functionality.

Claims 9 and 17 correspond to the apparatus claim 1. Accordingly, each is analyzed and rejected as previously discussed.

Claim 2 recites the apparatus of claim 1, wherein the indicator is displayed on a display of the apparatus. As discussed above, the combined systems of Sorensen and Huang disclose all limitations of claim 1, and Sorensen further teaches that the personal digital assistant (PDA) may generate *any form* of notification to alert the user to the presence of interactive data. (Col. 3, Ln. 22-36). Sorensen goes on to teach that the PDA may include a display used to notify the user of various other features. (Col. 5, Ln. 7-9). But, Sorensen fails to specifically disclose displaying an indicator. However, in light of the aforementioned teachings, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify the teaching of

Sorensen in order to provide a remote device capable of alerting the user to the presence of interactive data via the device display.

Claims 10 and 18 correspond to the apparatus claim 2. Therefore, each is analyzed and rejected as previously discussed.

Claim 3 recites the apparatus of claim 2, wherein the display changes background colors to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Sorensen and Huang disclose all limitations of claim 2, and Sorensen further teaches that the personal digital assistant (PDA) may generate *any form* of notification to alert the user to the presence of interactive data. (Col. 3, Ln. 22-36). In light of this teaching, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to modify this teaching of Sorensen in order to provide a system offering an alternative method of alerting a user to the presence of interactive data corresponding to the EPG.

Claims 11 and 19 correspond to the apparatus claim 3. Accordingly, each is analyzed and rejected as previously discussed.

Claim 4 recites the apparatus of claim 2, wherein the display flashes to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Sorensen and Huang disclose all limitations of claim 2, and Sorensen further teaches that the personal digital assistant (PDA) may comprise an LED which flashes, thereby alerting the user to the availability of the interactive function. (Col. 3, Ln. 22-36). Accordingly, the combined system of Sorensen and Huang contain all limitations of claim 4.

Claims 12 and 20 correspond to the apparatus claim 4. Thus, each is analyzed and rejected as previously discussed.

Claim 5 recites the apparatus of claim 1, wherein the apparatus is a personal digital assistant. As discussed above, the combined systems of Sorensen and Huang disclose all limitations of claim 1, and Sorensen further teaches that the remote device can be a PDA. (Col. 2, Ln. 33-34). Accordingly, the combined system of Sorensen and Huang contain all limitations of claim 5.

Claims 13 and 21 correspond to the apparatus claim 5. Thus, each is analyzed and rejected as previously discussed.

Claim 7 recites the apparatus of claim 1, wherein the indicator is a unit that generates a sound to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Sorensen and Huang contain all limitations of claim 1, and Sorensen further teaches the alert can be a sound. (Col. 3, Ln. 22-36). Accordingly, the combined system of Sorensen and Huang contain all limitations of claim 7.

Claims 15 and 23 correspond to the apparatus claim 7. Therefore, each is analyzed and rejected as previously discussed.

Claim 8 recites the apparatus of claim 1, wherein the indicator is a section of the apparatus that illuminates to indicate the availability of the interactive function in the program corresponding to the EPG. As discussed above, the combined systems of Sorensen and Huang contain all limitations of claim 1, and Sorensen further teaches the alert can be an LED, which may remain lit (i.e., illuminate). (Col. 3, Ln. 22-36). Accordingly, the combined system of Sorensen and Huang contain all limitations of claim 8.

Claims 16 and 24 correspond to the apparatus claim 8. Therefore, each is analyzed and rejected accordingly.

5. Claims 6, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen in view of Huang as applied to claim 1 above, and further in view of Elliot. (US Pat. No. 6,473,097).

Claim 6 recites the apparatus of claim 1, wherein the apparatus is a web phone. As discussed above, the combined systems of Sorensen and Huang contain all limitations of claim 1, but fail to specifically recite the use of a web phone. However, within the same field of endeavor, Elliot discloses a web phone capable of receiving multimedia data via the Internet, which is transmitted over RF frequencies. (Col. 3, Ln. 35-45 & Col. 4, Ln. 36-46). Also as discussed above, Sorensen teaches his system interacts with the remote via RF transmissions. (Col. 1, Ln. 30-40) In light of these teachings, it would have been obvious to one of ordinary skill in this art at the time of applicant's to combine the systems of Sorensen and Huang with the system of Elliot in order to provide a web phone capable of alerting a user of interactive data corresponding to an EPG, thereby providing a remoter terminal with extended capabilities.

Claims 14 and 22 correspond to the apparatus claim 6. Accordingly, each is analyzed and rejected as previously discussed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Goldstein (US Pat. No. 5,410,326) discloses a remote terminal capable of interacting with a variety of devices.
- b. Lappington et al (US Pat. No. 5,683,113) disclose an interactive system comprising a hand held terminal capable of displaying program information.
- c. Schultz et al (US Pat. No. 5,679,943) disclose a hand-held terminal capable of receiving a variety of information via RF transmissions.
- d. Nelson (US Pat. No. 5,710,605) discloses a remote terminal capable of displaying an EPG.
- e. Klosterman et al (US Pat. No. 5,940,073) disclose a EPG containing interactive data.
- f. Goulden et al (US Pat. No. 5,956,025) disclose a 3D EPG.
- g. Allport (US Pat. No. 6,097,441) discloses a system have integrated television and Internet content.
- h. Allport (US Pat. No. 6,104,334) discloses a portable device capable of displaying various interactive data.
- i. Takahasi (US Pat. No. 6,181,326) discloses a system which integrates Internet and television data.
- j. Harrison et al (US Pat. No. 6,209,132) disclose a system in which a hand held device can display interactive data.
- k. Terakado et al (US Pat. No. 6,246,441) disclose a hand held device which displays an EGP.
- l. Margulis (US Pat. No. 2001/0021998) discloses a wireless interactive system.

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- m. Gudorf (US Pat. No. 6,313,887) discloses a hand held device capable of displaying interactive data and alerting a user to its presence.
- n. Lortz (US Pat. No. 6,349,410) discloses an integrated broadcast television system comprising a remote device.
- o. Shen et al (US Pat. No. 6,401,059) disclose a broadcast system which utilizes a PDA as a remote terminal.
- p. Shim et al (US Pat. No. 6,640,113) disclose a touch sensitive remote terminal capable of receiving wireless signals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials *JK*
April 6, 2005.


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600